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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,843	02/19/2002	Thomas Bayer	4001-1023	2456

466 7590 12/16/2004

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,843

Applicant(s)

BAYER ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20030219</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 1 and 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
4. Regarding claims 1 and 7, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
5. Claims 1 and 7 recite the limitations "the recipient" and "the package". There is insufficient antecedent basis for these limitations in the claims.
6. With respect to Claim 1, the phrase "into an automatic distribution reader for the machine readable ID number" is indefinite. It is unclear to the examiner what is "for" the machine readable ID number. Does this mean when the card is inputted, it obtains the ID number?
7. Claim 1 recites the limitation "the basis" in line 20. There is insufficient antecedent basis for this limitation in the claim.
8. With respect to Claim 2: the phrase "as an additional condition" is indefinite. The prior claim does not really disclose any conditions, so it is unclear how this can be an additional

condition. Furthermore, does this mean that the following steps are not always performed, and what is the actual condition?

9. With respect to Claim 3: the phrase "and is retained" is indefinite. It is unclear to the examiner what is actually being retained.

10. With respect to Claim 4: this claim appears to insert a step into the independent claim, however, the claim is grammatically incorrect with what appears to be a list with multiple "and" in there, therefore it is unclear where the step is actually inserted, and furthermore, it is unclear as to what exactly is being done "before" everything else.

11. With respect to Claim 4: the phrase "if required" is indefinite. It is unclear if it is actually required or if it isn't?

12. Claim 5 recites the limitations "the payment", "the amount" and "the dispatch". There is insufficient antecedent basis for these limitations in the claim.

13. Claims 6 and 11 recites the limitation "the input code". There is insufficient antecedent basis for this limitation in the claims.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komel (4,894,717) in view of Curtis (5,509,572).

17. With respect to Claims 1 and 7: Komel discloses the use of a method for automatic distribution of packages (see abstract) comprising the steps of:

- a. Delivering a package notification card (Column 2, lines 45-50) with an ID on the card that is also on the package that is stored (Column 2, lines 18-44).
- b. Inputting the notification card into a reader (Column 2, lines 45-50)
- c. Retrieving the package from a storage locker and closing the locker after retrieval (Column 3, line 56 to Column 4, line 12).

18. Komel however fails to disclose that once the card is read, to automatically retrieve the item from storage, and to transport the item to a bin, where it is collected by a user. Curtis discloses a self-service pick-up machine, where a customer identifies their selves, the machine retrieves the item from a storage location and delivers it to a closeable area (See Figure 1, Column 2, lines 20-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Komel, to include the automatic retrieval of items from storage, as disclosed by Curtis, in order to provide a practical pick-up machine, which is completely automatic to reduce operational costs. (See Curtis, Column 1).

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19. With respect to Claims 2 and 8: See Komel, Column 2, lines 1-44.
20. With respect to Claim 3 and 9: See Komel, Column 2, lines 37-44.
21. With respect to Claim 6: Komel and Curtis, discloses the use of a car reader to read the notification card, but fail to disclose the reader being a handheld scanner.
22. At the time the invention was made it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the card reader be a handheld scanner, because Applicant has not disclosed that the use of a handheld scanner provides an advantage, is used for a particular purpose or solves any stated problem. One of ordinary skill in the art, furthermore would have expected Applicant's invention to perform equally well with a magnetic card reader or a handheld scanner, because both of these readers are equivalents in the art.
23. Therefore, it would have been an obvious matter of design choice to modify Komel and Curtis, to include a handheld scanner, as specified in Claim 6.
24. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komel and Curtis as applied to claims 1 and 7 above, and further in view of Stephens et al. (6,323,782).
25. Komel and Curtis, discloses the claimed invention except for the delivery facility transmitting package information to a central location for tracking purposes. Stephens discloses a delivery locker, where the status of the enclosure and item delivered to the enclosure is sent to a central processor, for tracking purposes (Column 10, line 62 to Column 11, line 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Komel and Curtis, to include sending status information about the item to a

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central processing controller, as disclosed by Stephens, in order for a user to be able to find out if and when an item has been delivered. See Stephens, Column 11)

26. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komel and Curtis as applied to claims 1 and 7 above, and further in view of Umeda et al. (6,010,064).

27. Komel and Curtis, discloses the claimed invention except for the use of payment being received before the item is given to the user. Umeda discloses of a commodity locker apparatus for picking up delivered items (See abstract), where the user pays for the service of the item before the lock on the locker is unlocked for the retrieval of the item (Column 5, lines 57-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Komel and Curtis, to include the means and steps of the user entering a payment before the item is retrieved, as disclosed by Umeda, in order to provide a less cumbersome, more reliable system for collection of charges of a service. (See Umeda, columns 9 and 10).

### *Conclusion*

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watabe (5,223,829) discloses a locker apparatus for storage of delivered items, and Hirschfeld et al. (4,997,076) discloses the use of a merchandise system which automatically retrieves goods from a storage location.

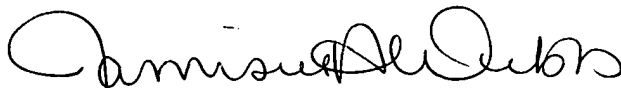
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579.

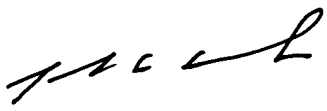
The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamisue Webb



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